

REMARKS

A USPTO Communication was sent to Applicants on April 12, 2006. The April 12 Communication indicated that Applicants' previous Amendment of January 30, 2006 was not fully responsive to the Office Action of August 31, 2005. Thus, Applicants are filing the present Amendment as being fully responsive to the August 31 Office Action. In particular, please refer to page 13 herein that refers to newly added claim 11.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Reply, claim 1 has been amended and claim 11 has been added. Thus claims 1-11 are pending in the present application.

No new matter has been added by way of the amendment to claim 1, since the amendments are for purposes of antecedent basis. This amendment also has support at page 4, fourth paragraph of the present specification. Thus, these are clarifying and not narrowing amendments to claim 1. By amending these terms in order to clarify the claimed invention (e.g., "member" to "members"), Applicants are in no way conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

No new matter has been added by way of new claim 11. New claim 11 has support in claim 1, as well as in the present specification at page 4, fourth paragraph.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the objection and all other rejections and allow the currently pending claims.

Substance of the Interview

Applicants thank the Examiner for her time, helpfulness and courtesies extended to Applicants' representative during the Interview of December 14, 2005. The assistance of the Examiner in advancing prosecution of the present application is greatly appreciated. In compliance with M.P.E.P. § 713.04, Applicants submit the following remarks.

The Interview Summary form amply summarizes the discussions at the Interview. Various ways of addressing the prior art rejections were discussed, and suggestions were discussed that may be drafted to cover particular aspects of the invention as not described by the prior art. Those suggestions have been adopted, as can be seen herein in Applicants' remarks below under the sections entitled "Claim Objection" and "Issues under 35 U.S.C. § 112, Second Paragraph."

Also discussed during the Interview were the differences between the presently claimed features and the embodiment shown in Figure 3 of the Yoshioka '023 reference (U.S. Patent No. 6,156,023). In particular, the Examiner stated that the presently claimed term of "portion" refers to "any part of a whole" (as stated in the Interview Summary). However, Applicants respectfully submit that this is not the case as explained in more detail below.

Claim Objection

Claim 1 stands objected due to informalities. Applicants respectfully traverse and respectfully refer the Examiner to the scope of claim 1 as presented herein. As can be seen, the Examiner's suggestions have been adopted, thereby overcoming this objection. Reconsideration and withdrawal of this objection is respectfully requested.

Issues under 35 U.S.C. § 112, Second Paragraph

Claims 1-10 stand rejected under 35 U.S.C. § 112, second paragraph, for several reasons of asserted indefiniteness (see pages 2-3 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

With regard to line 15 of instantly pending claim 1, Applicants respectfully submit that "elastic members" is recited, which properly refers to the elastic members appearing in line 10 of claim 1.

Regarding line 7 of pending claim 1, Applicants respectfully submit that this line refers to the skin-contacting surface portion. In contrast, line 18 of claim 1 does recite the folded back portion (for the first time), and also refers to the two sheet materials that constitute the three-dimensional guard.

Thus, Applicants respectfully submit that one of skill in art can read the instantly pending claims, especially in view of Applicants' written disclosure and Figures therein, and understand what is being claimed. The presented claims recite clear and definite claim language so that the skilled artisan understands the structure being claimed. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. § 102(e)

Claims 1, 2, 6 and 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yoshioka '023 (U.S. Patent No. 6,156,023) (as stated on pages 3-5 of the Office Action).

Also, claims 7 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by in view of Toyodo et al. '571 (WO 97/12571) (see pages 5-6 of the Office Action).

Applicants respectfully traverse both rejections, and reconsideration and withdrawal thereof are respectfully requested.

Yoshioka '023 Fails to Disclosed All Claimed Structural Features

Essentially, the Examiner is maintaining that Figure 3 of the Yoshioka '023 reference still discloses the present invention. Also mentioned during the recent Interview, the Examiner stated that the presently claimed term of "portion" refers to "any part of a whole" (as stated in the Interview Summary).

However, Applicants respectfully refer the Examiner to page 4, lines 19-28 of the present specification. At this part of the specification, Applicants describe how skin-contacting portion **5A** is folded back at a part of the location of the elastic member **54c** nearest to the raised portion **5B** (see also Fig. 2 to visualize how the portions define the three-dimensional guard). Further, page 4, lines 7-9 describes that the skin-contacting surface portion **5A** is formed by folding back a side portion on a free end **53** side toward the outer side of the diaper **1**. Thus, the term "portion" in "skin-contacting surface portion" refers to the area having the continuous sheet (that wraps around free end **53** to make top and bottom sheets), and not just a part of the continuous sheet.

As another example, in discussing how the stress of the skin-contacting portion **5A** is higher than the stress of the raised portion **5B** (see Applicants' specification at page 6, lines 15-27, in particular lines 24-27), the stress refers to the entire area or portion **5A** versus the entire area/portion **5B**. One of skill in the art would understand that the stress characteristics as discussed in the present specification do not refer to, e.g., just one point within the skin-contacting surface portion **5A** (see also how the stress is tested in the specification at page 7, starting at line 26, which refers to portions).

Applicants further note that instantly pending claim 1 recites that "said elastic members in the said second set in the raised portion is fixed between two sheet materials, wherein said two sheet materials form the three-dimensional guard." Thus, the raised portion, which is a part of the three-dimensional guard, has two sheet materials that surround the internal elastic members. Further, the skin-contacting surface portion is "formed by folding back a side on a free side towards an outer side of said absorbent article" and "is located more on a free end side than the folded back portion, and the region of the guard widthwise ranging from the folded back portion to the free end forms the skin-contacting surface portion" (see pending claim 1 as presented herein). Thus, the instantly claimed portions are not defined as "any part of a whole."

Further, Fig. 1 of this application shows a back side portion A as well as the other back side portion B. One of skill in the art, upon reviewing Fig. 1, would understand that "portion" of back side portion A refers to an area, and not just, e.g., sheet material **91** or just elastic members **92**. Applicants respectfully submit that the term "portion" is not defined as "any part of a whole." Instead, the instantly claimed three-dimensional guard has a skin-contacting portion, a raised portion, and a folded portion in between.

Thus, the instant rejection has been overcome based on the present claim language. Specifically, regarding the term “portion,” and in maintaining the rejection, the Examiner defines the area between elastic members **24B** and the first **24C** in the Yoshioka ‘023 Fig. 3 to be the skin contacting surface portion, and the area between elastic members of the second **24C** and **24A** in Fig. 3 to be the raised portion. However, this would mean that matching the instantly claimed folded portion would be in between the first **24C** and the second **24C** of Yoshioka ‘023. Specifically, instantly pending claim 1 recites that the three-dimensional guard is formed by: “a skin-contacting surface portion formed by folding back a side on a free side towards an outer side of said absorbent article.” Further, claim 1 of this application recites the location of the folded back portion as being: “located between the skin-contacting surface portion and said raised portion.” Therefore, in the present invention, the folded back portion is between the skin-contacting and raised portions, and the three-dimensional guard is formed by folding back the free side of the skin-contacting portion.

Regarding Yoshioka ‘023, Applicants further note the following description at column 4, lines 7-17:

The outer edge **27** of the sealing surface section **20** as the important part of the risen barrier cuff **19** comes in contact with a wearer's leg indicated by imaginary lines as the diaper is put on the wearer's body. With the outer side edge **27** being more tightly placed around the wearer's leg, the sealing surface zone **20** swings in a direction indicated by an arrow X around the first elastic member **24A** having the highest elongation stress and, as indicated by imaginary lines, is placed against the wearer's leg **32'** over its circumferential area as large as possible, whereupon the pocket **31** is opened as largely as possible.

Thus, as apparent from this excerpt in Yoshioka '023, one of ordinary skill in the art would understand that this cited reference discloses that the entire seal surface section **20** can be considered to correspond to the skin contacting surface portion of the present invention. That is, in Yoshioka '023, the elastic members **24A**, **24C**, **24C** and **24B** in Figure 3 are disposed in the area corresponding to the skin contacting portion of the present invention, and such elastic members are not disposed in the area corresponding to the raised portion of the present invention.

Thus, in relation to Fig. 3 of Yoshioka '023, which is relied upon by the Examiner to reject the pending claims, the folded back portion of the reference does not correspond to or match what is instantly claimed. As mentioned briefly above, Yoshioka '023 fails to disclose the specific location as well as the formation of the folded back portion of the present invention. Accordingly, Applicants respectfully submit that Yoshioka '023 is structurally different from the present invention and this rejection has been overcome. Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the rejection in view of the cited Yoshioka '023 reference has been overcome. *See Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants' position regarding the patentability of the present invention is also true for new claim 11, as can be seen herein. New claim 11 is similar to (rejected) claim 1, except does not recite "said folded back side forms a folded portion".

Further, Applicants respectfully maintain that the cited Yoshioka '023 reference discloses that its members **24A**, **24B** and **24C** are simultaneously contacting its skin contacting and raised

portions. This is in contrast to the separate set of elastic members as instantly claimed (different elastic members for each of skin-contacting portion and raised portion). Further, the claim language of “wherein said raised portion is located between said skin-contacting surface portion and a base end of said three-dimensional guard” physically separates the two sets of elastic members. Thus, Applicants respectfully submit that the present invention is structurally and patentably distinct from Yoshioka ‘023, including Figure 3 of the cited reference.

Based on the above, Applicants respectfully submit that the rejection in view of Yoshioka ‘023 has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Toyodo ‘571 Fails to Disclosed All Claimed Structural Features

In rejecting pending claims 7 and 9, the Examiner states that that “elastic members are not required for each portion” (Examiner’s emphasis added) (at page 6, lines 5-6 of the Office Action). However, Applicants respectfully submit that the present invention does use elastic members for each of the skin-contacting and raised portions. As can be seen from claim 7, the present invention is directed to “the elastic members in the skin-contacting surface portion of the three-dimensional guard are disposed at a smaller interval relative to the elastic members in the raised portion” (Applicants’ emphasis added). Applicants note the claim 9 depends on claim 7. Therefore, in this regard, each of Figures 1, 4, 6, 7 and 9 of the cited Toyoda ‘571 reference fails to disclose all claimed features, including how the elastic members in the skin-contacting portion are at smaller intervals than those elastic members in the raised portion. Thus, the rejection in view of Toyoda ‘571 has been overcome since the cited references fails to disclose all features as

recited in claims 7 and 9. *Verdegaal Bros., supra*. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshioka '023 (as stated on page 7 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested. Overall, Applicants do not concede that a *prima facie* case of obviousness has been established.

Lack of Disclosure of All Claims Features

Applicants respectfully submit that a *prima facie* case of obviousness has not been formed with respect to the asserted modification of Yoshioka '023, because not all requirements for a *prima facie* case of obviousness have been satisfied. In particular, there is no disclosure of all claimed features as mentioned above. Each of disputed claims 3-5 depends on claim 1, wherein claim 1 is directed to using the two sets of elastic members. Thus, Applicants submit that this rejection under § 103(a) has been overcome, since U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a

reasonable expectation of success. *See In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Here, not even the first requirement of disclosure of all claimed features has been satisfied, since the cited Yoshioka '023 reference does not disclose the formation and location of the instantly claimed folded portion (e.g., between the skin contacting portion and the raised portion).

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established since not all requirements thereof have been satisfied and that this rejection has been overcome. Withdrawal of this rejection is respectfully requested.

Inoperability: Lack of Motivation and/or Reasonable Expectation of Success

Applicants also submit that the other requirements of the requisite motivation and/or reasonable expectation of success for a *prima facie* case of obviousness have not been satisfied. Applicants further note that the initial burden of establishing a *prima facie* case of obviousness lies with the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). That burden has not been met here as explained below.

First, Applicants submit that the disclosure in Yoshioka '023 is in contrast to the instantly claimed invention which employs the two sets of elastic members.

Second, Yoshioka '023 requires that its elastic members **24** be in contact with sealing surface zone **20** and simultaneously in contact with sections **17**, **18** and **16** (see its Figure 3 and column 3, lines 13-22).

Thus, the rejection in view of Yoshioka '023 (as modified in the Office Action) has been overcome. This is because the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. *See* M.P.E.P. §§ 2143.01 (see sections entitled "The Proposed Modification Cannot Render the Prior Art Unsatisfactory For Its Intended Purpose" and "The Proposed Modification Cannot Change the Principle of Operation of a Reference") and M.P.E.P. § 2145(III); *see also re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, the intended purpose of Yoshioka '023 is to provide the better sealing surface zone **20** that includes the overhand section **17** and the second overhang section **18** (see, e.g., column 1, lines 16-24 and column 2, lines 52-59). To match the present invention, the overhand section **18** of Fig. 3 of Yoshioka '023 would have be folded between the two elastic members **24C** (these features are described in the '023 specification at, e.g., column 3, lines 13+). One of ordinary skill in the art would understand that folding the middle section of overhand section **18** would defeat the intended purpose of the Yoshioka '023 embodiment. Applicants further note that Fig. 3 shows a shadow of how overhang sections **17** and **18** is suppose to be bent upon usage (section **18** would bend down and to the left, **17** to the right and up). Thus, the Yoshioka '023 reference would be rendered inoperable for its intended purpose and the requisite motivation is lacking for the instant rejection. Alternatively, the principle operation of Yoshioka '023 would be destroyed for the reasons stated above. Accordingly, this rejection has been overcome.

Further, the requisite motivation and/or reasonable expectation of success are lacking since one of ordinary skill in the art would not reasonably expect to be successful, upon reading Yoshioka '023, in achieving the presently claimed invention when that skilled artisan has to

change the overhand sections of the Yoshioka '023 embodiment (as explained above). Applicants respectfully submit that it is not *prima facie* obvious to modify a reference unless the references suggest an advantage to be gained from the modification. *See In re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983). Yoshioka '023 discloses not such advantage to bending overhang section 18 to match what is instantly claimed. If anything, the function of overhang sections 17 and 18 in Yoshioka '023 are that these sections are suppose to be bent upon usage (wherein section 18 would bend down and to the left, 17 to the right and up based upon the shadowed part in Fig. 3), and not be folded in between. Thus, Applicants submit that the requisite motivation and/or requisite reasonable expectation of success is further lacking.

Moreover, the cited references must suggest the desirability of the modification. *In re Brouwer*, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). The cited Yoshioka '023 reference does not suggest any advantage to be gained by making the Examiner's proposed combination. Thus, this is an additional reason as to why this rejection has been overcome.

Accordingly, Applicants respectfully submit that the instant rejection under § 103(a) has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Application No. 10/019,650

Docket No.: 0445-0316P

Art Unit 3761

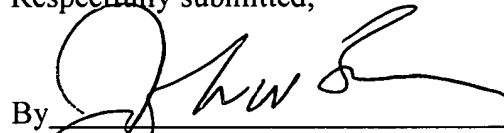
Reply to Office Action of August 31, 2005

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: MAY - 2 2006

Respectfully submitted,



By _____
John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant